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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,306	06/22/2001	Rogelio Robles	10990665-1	6814

7590 - 03/29/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/887,306	ROBLES ET AL.	
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the amendment, and 37 CFR 1.131 affidavit filed on 12/10/2004.

This action is made Final.

2. In the amendment, claims 1-40 are pending in the case. Claims 1, 9, 19, and 29 are independent claims.

Drawings

3. The drawings filed on 6/22/2001 have been approved by the examiner.

Response To Declaration under 37 CFR § 1.131

6. The Affidavit filed on 12/10/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the effective filing date of the Van Der Linden US Patent Publication, 8/16/2001, filed on 12/28/2000, Foreign EPO application filed on 1/4/2000.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country both prior to, and after the effective date of the Van Der Linden reference, up to the date of constructive reduction to practice (i.e. filing date of the present application).

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In addition, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Van Der Linden reference to either a constructive reduction to practice or an actual reduction to practice.

Moreover, each exhibit relied upon should be specifically referred to in the declaration in terms of what it is relied upon to show. The declaration must clearly explain which facts or data applicant is relying on to show that the invention was completed prior to a certain date. There is no explanation as to how "Exhibit A" relates to the claimed invention. The declaration does not show which claims are supported by exhibit A, and which limitations are supported by a certain portion of the exhibit. In addition, the description of the invention does not appear to be part of the disclosure in exhibit A, because the Exhibit only contained 2 (page 2) not 7 pages, as it is implied by the exhibit.

Further, the applicant must clearly explain the exhibits, drawings, or any evidence which forms part of the declaration, to point out exactly what facts are established and relied upon to support the declaration, in order to meet the statutory requirements of 37 CFR 1.131. There is no explanation detailing in what manner the figures submitted support the claimed invention.

The applicant has included a general and vague statement as to when the invention was conceived (including what seems a correction of the "Jan 25 1998", by replacing 1998 with 1999 in pen, o page one of two), and the proof of conception, and reduction to practice. A mere statement declaring that the invention was conceived or reduced to practice by a specific date predating the applied prior art reference is insufficient to satisfy 37 CFR 1.131.

Exhibit A, and the description of the invention just present vague evidence of diligence and reduction to practice at best. However, it is not clear from these exhibits what the invention

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was or which claims, drawings, etc., were being referred to. For example, the description of the invention does not seem to be part of exhibit A. Since these exhibits only describe ancillary statements of the conception of the invention, not reduction to practice date, and not the facts established and relied upon supporting the statements of the applicant, they do not represent enough information to meet the requirements of 37 CFR 1.131.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include attached sketches, blueprints, photographs, reproduction of notebook entries, accompanying models, supporting statements by witnesses, interference testimony, and/or prior submission to the USPTO of Disclosure Documents.

In view of the examples of support as explained above, it is the Examiner's opinion that the presented combination of evidence within exhibit A (a signed copy of an invention disclosure not clearly explaining which facts are relied upon to back up the conception, and reduction dates of the invention), is insufficient proof that Applicant's invention was conceived and/or reduced to practice before the filing date of Van Der Linden. Accordingly, said affidavit is ineffective to overcome the effective filing date of the Van Der Linden reference at the present time (see MPEP 8th Edition, section 715.07).

Claim Rejections - 35 USC § 112

4. Appropriate corrections have been made to claims 32, 38 . Therefore the rejections of claims 32-40 under 35 U.S.C. 112, second paragraph, have been withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-18, 24, and 35 remain rejected under 35 U.S.C. 102(e) as being anticipated by Van Der linden et al, hereinafter Vanderlinden (US Pub.# 2001/0013947 A1, 8/16/2001, filed 12/28/2000, Foreign EPO application filed on 1/4/2000).

Regarding independent claim 19, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver—*capture driver operable to capture the document production request*, which generates a temporary print file. A submission form, which is displayed by a browser—*interface translator--*, has pull-down menus, and control buttons for selecting printers, and print options, and submitting the print job (0038-0046, fig.,3).

Furthermore, a reproduction center—*production server--* is connected with a client via a network, for routing the print job according to the selected printers and print options—*direct one or more selected devices to produce the captured document*, to a printer which capable for executing this job. The submission form includes messages for displaying the change in devices capabilities—*potential services* offered by the reproduction center--as a result of automatic

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updates of the submission form. A scheduler—*production engine*-- routes the print jobs to the appropriate printers to complete the job (0035, 0042-0044, 0048-0049, 0059-0060).

Regarding claim 20, which depends on claim 19, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver, which generates a temporary print file version of the document (in Postscript printer language) to be printed. Once entries have been made, the submission form is transmitted to the reproduction center (0046-0048).

Regarding claim 21, which depends on claim 19, Vanderlinden discloses the submission of print jobs, using a submission form, to a reproduction center by a client computer over a network. The submission form is displayed by a browser—*interface translator*-- (0035-0041, fig.,3).

Regarding claim 22, which depends on claim 21, Vanderlinden discloses the automatic update—*identify services available on the network*-- of the submission form to include a description outlining change in devices capabilities (0051, 0059, fig.3).

Regarding claim 23, which depends on claim 21, Vanderlinden discloses the use or query of a device capability store—*database of known services*-- for automatically updating the submission form to include a description outlining change in devices capabilities (0051, 0059, fig.3).

Regarding claim 25, which depends on claim 19, Vanderlinden teaches the editing or changing of the submission form's pull-down menu—*device identifier to identify* printers available at the reproduction center-- to update functionalities available at the reproduction center, such as the adding a new printer to a pull-down menu for selecting the printer, as a result of the addition of a new printer capable of printing transparent. The updated information is placed, and displayed in the form's pull-down menu using a browser (0016, 0041, 0051, 0059, fig.3).

Regarding claim 26, which depends on claim 19, Vanderlinden discloses that the reproduction center has a print queue for placing waiting-to-be-processed print jobs (0056,fig.3).

Regarding claim 27, which depends on claim 26, Vanderlinden discloses that the reproduction center has an operator console for displaying waiting-to-be-processed print jobs from the print queue (0056,fig.3).

Regarding claim 28, which depends on claim 19, Vanderlinden discloses a program module for establishing a network connection with the reproduction center—*locating* a print server (0040).

Regarding independent claim 29, Vanderlinden discloses a print server computer—*second computing device--* is connected to a client computer—*first computing device--* via a network, for routing the print job according to selected printers—*document production devices--*

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and print options, to a printer which capable for executing this job. The print job is sent to the printer and printed in a PDF format—*device specific format* (0035-0041, 0048-0050,0059-0060, fig.1-2).

Regarding claim 30, which depends on claim 29, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver. An activation of the driver generates a temporary print file version of the document (in Postscript printer language) to be printed. The print file is transferred to the reproduction center to be printed. A submission form displayed on a browser—*Interface Translator--*, having buttons, and menus for formatting the document which is to be printed (0037-0048, fig.3).

Regarding claim 31, which depends on claim 30, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver. An activation of the driver generates a temporary print file version of the document (in Postscript printer language—*generic format*) to be printed. The print file is transferred to the reproduction center to be printed (0037-0041, fig.1-2).

Regarding claim 32, which depends on claim 29, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities—*potential services* offered by the reproduction center--as a result of automatic updates of the submission form. A scheduler—*production engine--* routes the print jobs to the appropriate printers to complete the job (0035, 0042-0044, 0048-0049,0059-0060).

Regarding claim 33, which depends on claim 32, Vanderlinden discloses the submission of print jobs to a reproduction center's print server, using a submission form. The submission form is displayed on a browser—*Interface Translator*--, having buttons, and menus for formatting the document which is to be transferred printed (0041-0048, fig.1-3).

Regarding claim 34, which depends on claim 32, Vanderlinden discloses the use or query of a device capability store—*services database* -- for automatically updating the submission form to include a description outlining change in devices capabilities. The device capability store is also used for routing the documents to be printed (0051, 0059,fig.3).

Regarding claim 36, which depends on claim 34, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities as a result of updates made to the device capabilities store—*services database updated with services not currently represented in this database*-- (0059-0060).

Regarding claim 37, which depends on claim 36, Vanderlinden discloses the update or addition—*identification new devices*-- of new printers to a device capabilities store. Each printer is associated with a corresponding print driver (0037-0038, 0051, and 0059).

Claims 38-40 are directed towards a computer system for implementing the steps found in claims 25, and 27-28 respectively, and therefore are similarly rejected.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-18, 24, and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderlinden.

Regarding independent claim 1, Vanderlinden discloses the submission of print jobs to a reproduction center, where documents are to be printed upon the receipt of a submission form. The submission is transmitted by a client—*first computing device*-- through a submission form—*production request*—which indicates controls for allowing a user to select print options—*services*-- currently available at the reproduction center (0010, 0016, fig.1-2, 3).

Furthermore, Vanderlinden teaches creating a job ticket, containing job specifications—*merging selected services and captured document production request into a production plan*-- found on the form submitted by the client. The print job ticket—*production plan*-- is then routed to a printer capable of printing the document (0011, 0050, 0060, fig.3). Vanderlinden fails to explicitly disclose: *delivering the document production plan in a device specific format*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have delivered the plan in a device specific format, because Vanderlinden teaches

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above routing job tickets to a printer capable of executing the job at the lowest possible costs.

Thus printing documents at a minimum price at a printer which understands and is able to carry out the print request.

Regarding claim 2, which depends on claim 1, Vanderlinden teaches the changing of the submission form to update capabilities available at the reproduction center, such as the adding a new printer to a pull-down menu as a result of the addition of a new printer capable of printing transparent (0051).

Regarding claim 3, which depends on claim 2, Vanderlinden teaches the changing of the submission form to update capabilities available at the reproduction center, such as the adding a new printer to a pull-down menu as a result of the addition of a new printer capable of printing transparent (0051).

Regarding claim 4, which depends on claim 2, Vanderlinden teaches the changing of the submission form to update capabilities available at the reproduction center, such as the adding a new printer to a pull-down menu as a result of the addition of a new printer capable of printing transparent (0051). In other words, when the new printer is detected or queried by the client computer, then the update will take place on the submission form.

Regarding claim 5, which depends on claim 2, Vanderlinden teaches the changing of the submission form to update capabilities available at the reproduction center, such as the adding a

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new printer to a pull-down menu as a result of the addition of a new printer capable of printing transparent. The updated printer information is obtained from a device capability store—*querying a service database* (0051, 0059).

Regarding claim 6, which depends on claim 1, Vanderlinden teaches the conversion of a document submitted by the client, into a format, such as PDF—*generic format*-- which is more suitable for processing by the reproduction center (0051). In other words, when the new printer is detected or queried by the client computer, then the update will take place on the submission form.

Regarding claim 7, which depends on claim 1, Vanderlinden teaches the changing of the submission form to update functionalities available at the reproduction center, such as the adding a new printer to a pull-down menu for selecting the printer, as a result of the addition of a new printer capable of printing transparent (0016, 0051, 0059, fig.3).

Regarding claim 8, which depends on claim 1, Vanderlinden teaches the display of a list of all pending print jobs along with their current status, such as waiting, being printed, or is completed (0056-0059). In other words, the status is monitored to determine the progress of the print job, and then that status is displayed on the list.

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Regarding claim 10, which depends on claim 9, Vanderlinden teaches the submission of a print job over a network to a reproduction center using a form displayed on a web browser (0040-0047).

Regarding claim 15, which depends on claim 14, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities as a result of updates made to the device capabilities store—*services database updated with services not currently represented in this database--* (0059-0060).

Regarding claim 16, which depends on claim 15, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities as a result of updates made to the device capabilities store—*services database updated with services not currently represented in this database—such as the addition of new printers—services not available on the network and services database and updating the database with the new printer added to the reproduction center* (0051, 0059-0060).

Claims 9, 11-14, 17-18 are directed towards a computer program product on a computer-readable medium for storing the steps found in claims 1-5, and 7-8 respectively, and therefore are similarly rejected.

Regarding claim 24, which depends on claim 23, Vanderlinden discloses the use or query of a device capability store—*database of known services--* for automatically updating the

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submission form to include a description outlining change in devices capabilities. This invention also indicates the print status of printers, whether or not a print job is being printed or is completed (0056). Vanderlinden fails to explicitly disclose: *querying the document production devices*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have query the printers for their status, because this provides the benefit of quickly informing the user of the condition of a print job, so that the user would take necessary steps in case of a malfunction or printer error.

Regarding claim 35, which depends on claim 34, Vanderlinden discloses the use or query of a device capability store—*services database* -- for automatically updating the submission form to include a description outlining change in devices capabilities. The device capability store is also used for routing the documents to be printed (0051, 0059, fig.3). Vanderlinden fails to explicitly disclose: *querying the document production devices*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have query the printers for their status, because this provides the benefit of quickly informing the user of the condition of a print job, so that the user would take necessary steps in case of a malfunction or printer error.

Response to Arguments

9. Applicant's arguments filed 12/10/2004 have been fully considered but they are not persuasive. Applicants indicate that the 131 affidavit establishes both a conception, diligence, and constructive reduction to practice (page 1 of the remarks). As set forth above, the 131

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declaration is insufficient to establish conception, diligence, and reduction to practice before the Vanderdinden reference. Therefore, claims 1-40 remain rejected.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450

Application/Control Number: 09/887,306

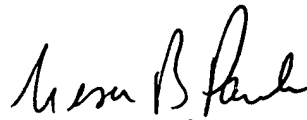
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Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

3/28/05